

REMARKS

Reconsideration of the present application in view of the above amendments and following remarks is respectfully requested.

Status of the Claims

Claims 1-28 are currently pending.

Claims 1-28 were rejected under 35 USC 103(a) as being unpatentable over Fell et al. (US20040253894) in view of Goodman et al. (WO 93/12749).

Claim Rejections Under 35 USC 103

Claims 1-28 were rejected under 35 USC 103(a) as being unpatentable over Fell et al. (US20040253894) in view of Goodman et al. (WO 93/12749). The Examiner's rejection is respectfully traversed. The claimed invention is directed to a sanitary napkin including an apertured film cover layer having a high open area. However, despite the presence of the high-open area cover layer the napkin surprisingly still provides superior rewet and masking. It is respectfully submitted that neither Fell et al. and/or Goodman, either singularly or in combination, teach or suggest a sanitary napkin structure that includes an apertured film having a high open area and also provides superior rewet and masking properties as claimed.

In the Office Action at page 3 the Examiner states that "applicant does not establish sufficient criticality for a rewet less than 0.05 grams, therefore such a rewet amount is considered to be an optimization." The Examiner further states that "it would

be obvious to one of ordinary skill in the art to modify the core 16 taught by Fell so as to effect a rewet according to the method taught by Fell that is less than 0.05 grams. As noted above, the present invention provides an absorbent article that has a high open area cover, i.e. an open area between about 20% and about 30%, that surprisingly still provides superior rewet and masking characteristics. It is respectfully submitted that modifying the core as proposed by the Examiner would still not provide an article according to the claimed invention. That is, the Examiner's proposed modification would not provide an absorbent article having a cover with an open area between about 20% and about 30% that surprisingly still provides superior rewet and masking characteristics.

In the Office Action at page 3 the Examiner further states that "Fell teaches forming the body-side liner with an amount of titanium dioxide pigment of 6 wt% to give the liner a clean white appearance." The Examiner then appears to conclude that this *single* statement establishes that the article disclosed in Fell would inherently have the masking properties of the claimed invention. It is respectfully submitted that the Examiner has failed to establish a prima facie case of inherency. To rely upon a theory of inherency for rejections under section(s) 102/103, "the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art." *Ex Parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990) (emphasis in original). Furthermore, it is well established that "the fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic." MPEP §2112 (citing *In re Rijckaert*, 9 F.3d 1531, 1534 (Fed. Cir. 1993) (reversed rejection because inherency was based on what would result due to

optimization of conditions, not what was necessarily present in the prior art) (emphasis in original).

In the instant case, it is respectfully submitted that the Examiner has failed to provide, as required by Federal Circuit precedent and by the MPEP, any basis in fact and/or technical reasoning to reasonably support the conclusion that a person following the express teachings of Fell would necessarily and invariably achieve an absorbent article having the characteristics recited in the claims. That is, the Examiner has not explained how and why one of skill in the art, varying the extensive list of materials described in Fell, might not achieve an article that has characteristics outside the ranges recited in claim 1 and claim 28. It appears that one of skill in the art following the teachings of Fell could quite readily develop an article having characteristics outside the claimed range by varying the materials within the broad laundry list of materials listed in Carstens. Accordingly, the teachings of Fell do not *necessarily and invariably* lead to an article having the claimed properties, and thus Examiner's assertion of inherency is improper.

In the Office Action at page 3 the Examiner acknowledges that Fell fails to teach an absorbent article having a cover with an open area between about 20% and about 30%. To overcome this acknowledged shortcoming, the Examiner contends that Goodman teaches an apertured film having an open area of between 5%-35%. The Examiner thus concludes that it would have been obvious to one of skill in the art to modify the article of Fell to include a cover as taught by Goodman to thereby “arrive” at the claimed invention. As discussed above it is respectfully submitted that the Examiner has failed to establish that Fell would inherently provide the masking and rewet properties of the

claimed invention. Thus, it is respectfully submitted that modifying the article of Fell to further include the cover material disclosed by Goodman would still fail to teach or suggest the claimed invention. Moreover, even assuming *arguendo* that Fell does disclose an article having the claimed rewet and masking properties, modifying such article to have a cover with an open area between 20% and 30% would most assuredly diminish the very same rewet and masking properties. Thus, it is respectfully submitted that the Examiner's proposed modification of Fell would still fail to provide an article having the *combination* of a cover with an open area between 20% and 30%, and the claimed rewet and masking properties.

Filed concurrently with this Response is a Rule 132 Declaration from the named inventor William G.F. Kelly. The declaration indicates that William G.F. Kelly constructed an absorbent article in accordance with the alleged teachings of Fell and Goodman identified by the Examiner and tested such absorbent article in accordance with the test methods set forth in the present application. As set forth in the Declaration an absorbent article constructed in such a manner did not possess the recited masking value of the claimed invention. That is, the constructed article did not have a masking value of less than about 115,000.

In view of the above it is respectfully submitted that the applicant has clearly established that the cited references do not inherently teach the claimed invention nor would be obvious to combine the teachings of the cited references to thereby render the claimed invention obvious.

In view of the above remarks it is respectfully submitted that the application is now in condition for allowance. The Examiner is invited to call the applicant's undersigned representative if any further action will expedite the prosecution of the application.

In the event that any fees are due for entry of the present amendment the Commissioner is hereby authorized to charge such fees to Deposit Account No. 10-0750/PPC-5053-USANP/PJH.

Respectfully submitted,

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